

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

Status of Claims

Claims 1-16 and 23-27 are currently pending in the application of which claims 1, 9, and 23 are independent. Claims 1-16 and 23-27 were rejected.

By virtue of the amendments above, claim 26 has been amended.

No new matter has been introduced by way of the amendments above. Entry thereof is therefore respectfully requested.

Summary of the Office Action

Claims 23-25 were rejected under 35 U.S.C. §112, first paragraph, as allegedly being drawn to a single means claim.

Claims 26 and 27 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 5-16 and 23-27 were rejected under 35 U.S.C. 102 (e) as allegedly being anticipated by Xu et al. (7,266,125, hereinafter Xu).

Claims 1-3, 5, 9-14 and 23-25 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Tzamalouka (6,862,500).

Claim 4 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Tzamalouka in view of the Paper entitled "Building Low-maintenance Expressways for P2P Systems" by Zhang (hereinafter Zhang).

The aforementioned rejections are respectfully traversed for at least the reasons set forth below.

Claim Rejection Under 35 U.S.C. §112

Claims 23-25 were rejected under 35 U.S.C. §112, first paragraph, as allegedly being drawn to a single means claim.

Applicants respectfully submit that the Office Action's allegation is improper.

MPEP § 2164.08(a) states:

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

The Examiner bases the allegation that claims 23-25 are drawn to a single means claim on the Appeal Brief supplement filed 6/19/2009 which shows as an example that the means for each of the claimed limitations could be performed by a processor. The Examiner goes on to state that the applicant is not entitled to a claim for a processor since the applicant has not disclosed anything novel about the processor. However, the Examiner misinterprets MPEP § 2164.08 and *In re Hyatt*. *In re Hyatt* pertained to a claim that contained only one limitation and that limitation was in the form of a means plus function. However,

independent claim 23 contains three separate limitations, each tied to a separate means plus function. Thus, claim 23 is not analogous to the claim in *In re Hyatt*. Further, the plain language of MPEP § 2164.08 defines a single means claim as a claim “where a means recitation does not appear in combination with another recited element of means.” Claim 23 contains means recitations, but they are clearly in combination with other recited elements of means (the further limitations). Thus, the rejection under § 112, first paragraph, is improper.

Claims 26 and 27 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 26 has been amended per the Examiner’s recommendation. The rejection under § 112, second paragraph, is believed to be overcome.

Accordingly, withdrawal of the rejection is respectfully requested.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

A. Claims 1-3, 5-16 and 23-27 were rejected under 35 U.S.C. 102 (e) as allegedly being anticipated by Xu.

In rejecting claims 1-3, 5-16 and 23-27 the Examiner only cites Xu figures 2-6 and corresponding text as teaching each feature of each claim, with the exception of claim 23. Such a generalized statement that such a large portion of the reference teaches each feature of each claim is insufficient. "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." (Emphasis added). 37 CFR § 1.104(c)(2) and MPEP § 706. The Applicant contends that the Examiner has not met his requirement for particularly pointing out to the extent practicable the portions of Xu that he is relying on as allegedly teaching the Applicant's claims.

Xu does share a common inventor with the present application and is based on a similar field of invention. Thus, some of the figures are indeed similar. However, Xu does not teach the claimed portions of the present applications. Xu, as disclosed by figures 2-6 and their corresponding text, describes a system and method for an auxiliary network for a peer-to-peer overlay network using landmark numbering and also describes using information available through the auxiliary network. For example, expressway connections are established amongst expressway nodes and ordinary connections are established between ordinary and expressway nodes.

Claim 1 recites, “searching through a map associated with a region of the overlay network using the first proximity information, wherein the map includes proximity information associated with locations of nodes physically close in the physical network.” The Examiner fails to particularly point out which feature of Xu he believes teaches this feature of claim 1. Regardless, Xu fails to teach searching through a map associated with a region of the overlay network using first proximity information. A similar feature is recited by independent claims 9 and 23 and these claims are also believed to be allowable.

The Examiner cites Xu column 8, lines 31-60 as teaching this feature in regards to claim 23. The section cited discloses that the routing state may be summarized so that the routing table size may be smaller. The section also generally discloses that the exemplary embodiments of the invention described in Xu are to be understood that various modification may be made without departing from the scope of the invention. Neither of these sections teach the above mentioned feature of claim 23. Thus, Xu fails to teach or suggest searching through a map associated with a region of the overlay network using the first proximity information, wherein the map includes proximity information associated with locations of nodes physically close in the physical network.

B. Claims 1-3, 5, 9-14 and 23-25 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Tzamalouka.

Claim 1 recites, “searching through a map associated with a region of the overlay network using the first proximity information, wherein the map includes proximity information associated with locations of nodes physically close in the physical network.” The Examiner alleges that this feature is taught by Tzamalouka column 5, lines 3-35, stating that “the central geographic database is the map” (Office Action page 10). This section of

Tzamalouka discloses that virtual private tunneling networks are created and used for communicating between a central server and fixed and mobile egress points, and that a virtual overlay network can be formed using a plurality of tunnels. Further, Tzamalouka discloses that the central server comprises a central geographic database and receives content from the egress points and participating vehicles (mobile egress points), and the central database may be updated at various times based on this information. However, the central geographic database is not equivalent to the map of claim 1 **as Tzamalouka does not disclose that the central geographic database includes proximity information associated with locations of nodes physically close in the physical network.** Further, Tzamalouka fails to disclose that a central geographic database associated with a region of the overlay network is searched. Thus, Tzamalouka fails to teach or suggest searching through a map associated with a region of the overlay network using the first proximity information, wherein the map includes proximity information associated with locations of nodes physically close in the physical network.

Independent claims 9 and 23 recite features similar to claim 1 and are believed to be allowable at least for the same reasons stated above.

Accordingly, reversal of the rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S.398, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of

ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S.398, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

- **Claim 4**

Claim 4 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Tzamalouka in view of Zhang.

Zhang is not relied upon to teach the feature of claim 1 discussed above, nor does it. Since Zhang fails to remedy the deficiencies of Tzamalouka, claim 4 is believed to be allowable for at least the reasons stated above regarding claim 1.

Accordingly, reversal of the rejection is respectfully requested.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited. Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to Deposit Account No. 08-2025.

Respectfully submitted,

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